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10/643,987	08/20/2003	Marybeth Ahern	00240293US	5154
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Andrew M. Calderon Greenblum and Bernstein P.L.C. 1950 Roland Clarke Place Reston, VA 20191				
EXAMINER KARDOS, NEIL R				
ART UNIT 3623		PAPER NUMBER		
NOTIFICATION DATE 07/09/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

### Office Action Summary

**Application No.**

10/643,987

**Applicant(s)**

AHERN ET AL.

**Examiner**

Neil R. Kardos

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8, 10, 32-41 and 52-56 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8, 10, 32-41 and 52-56 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This is a **FINAL** Office action on the merits in response to Applicant's amendments amendment filed April 23, 2008.. Claims 1, 32, and 52 have been amended. Claims 9, 11-31, and 42-51 have been cancelled. Claims 53-56 have been added. Currently, claims 1-8, 10, 32-41, and 52-56 are pending and have been examined.

***Remarks***

2. Claim Objections

Applicant's cancellation of claim 9 is sufficient to overcome the claim objections set forth in paragraph 3 of the previous Office action. Thus, the claim objections are withdrawn.

3. Rejections under § 112

Applicant's arguments are sufficient to overcome the § 112 rejections set forth in paragraph 5 of the previous Office action. Thus, this rejection is withdrawn.

4. Rejections under § 101

Applicant's amendment to claim 32 is sufficient to overcome the § 101 rejections set forth in paragraph 7 of the previous Office action. Thus, this rejection is withdrawn.

5. Rejections under § 103

Applicant's amendments to claims 1, 32, and 52 are sufficient to overcome the prior art rejections under § 103 set forth in paragraph 9 of the previous Office action. These amendments necessitate the new prior art rejections, set forth below.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-8, 10, 32-41, and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ann (US 2002/0198727) in view of Pisello (US 2003/0158800).**

Claim 1: Ann discloses method for managing and tracking changes, the method comprising the steps of:

- defining at least one customer requirement for an enhancement to an enterprise architecture (see figure 5, disclosing strategic directions 302; ¶ 9, disclosing business requirements and objectives; ¶¶ 34 and 37);
- identifying at least one capability to provide the enhancement to the enterprise architecture (see figure 5, disclosing capabilities 304 supporting strategic directions 302; ¶¶ 13, 27, 36, 41, and 43, disclosing capabilities); and
- partitioning information relevant to enterprise decision making for evolutionary change by creating categories of the information and relating these categories to one another (see e.g. figure 5, depicting categories and their relationships) and

automating the management of the categories of the information by an automation system (see e.g. ¶ 29, disclosing storing the categories and relationships in a computer), the information being defined by at least one of the value, the at least one capability (see figure 5, capabilities 304), and operational resources (see figure 5, organization units 312, roles & responsibilities 314, processes 316; ¶ 33).

Ann does not explicitly disclose:

- estimating at least one of a revenue increase and a cost saving associated with the at least one capability;
- determining a value provided by the at least one capability based upon an implementation cost and the at least one of the revenue increase and the cost saving

However, Ann does disclose analyzing the impact of proposed enterprise changes prior to implementation (see ¶¶ 6, 14, and 47).

Pisello teaches estimating at least one of a revenue increase and a cost saving associated with a potential IT project to support organizational goals (see ¶¶ 39 and 43, disclosing cost savings associated with the IT project). Pisello also teaches determining a value provided by the IT project based on implementation cost and at least one of the revenue increase and the cost saving (see ¶ 33, disclosing determining IT costs; ¶¶ 39 and 43, disclosing cost savings; ¶ 40, disclosing a cost-benefit template; ¶¶ 51-56 disclosing cost-benefit indices for the projects; ¶ 91).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the analysis techniques taught by Pisello when analyzing the impact of

proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 2: Ann discloses mapping the at least one customer requirement to the at least one capability (see figure 5, items 302 and 304; ¶ 41).

Ann does not explicitly disclose comparing the value provided by the at least one capability with another value provided by at least one other capability and determining which capability provides optimum value.

However, Ann does disclose comparing proposed changes to the enterprise (see paragraph 47).

Pisello teaches comparing values of capabilities to determine the best implementation (see ¶ 91, disclosing comparing IT projects based on their values).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the comparison techniques taught by Pisello when comparing the proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate determination of the best possible implementation.

Claim 3: Ann discloses wherein the identifying step includes identifying one or more strategic resources to support the at least one capability (see figure 5, items 316, 314, and 312; ¶¶ 13, 33, and 41-43).

Claim 4: Ann discloses wherein the identifying at least one capability step includes identifying at least one of a business process (see figure 5, item 316), a personnel skill/competency (see figure 5, item 314; ¶ 33), a physical entity (see figure 5, item 320), an information technology (see figure 5, item 342), a system component (see figure 5, item 330), and an infrastructure component (see figure 5, item 340).

Claim 5: Ann does not explicitly disclose assigning a weight to the one or more strategic resources and prioritizing the one or more strategic resources based on the assigned weight.

Pisello teaches this limitation (see ¶ 34, disclosing assigning costs to resources for a project, which weigh into and prioritize the project that is eventually chosen; ¶¶ 36 and 40; ¶ 41, disclosing key performance indicators which constitutes a measure of IT improvement). Furthermore, it is old and well-known in the art to prioritize items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weighting techniques taught by Pisello when analyzing change impact as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate representation of the impact associated with enterprise changes.

Claim 6: Ann does not explicitly disclose assigning outcome based performance metrics to the one or more strategic resources.

Pisello discloses this limitation (see ¶¶ 41-47, disclosing KPIs related to proposed IT projects).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metrics taught by Pisello when analyzing the impact of changes as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 7: Ann discloses implementing the one or more strategic resources (see ¶ 47).

The combination of Ann and Pisello does not explicitly disclose tracking the one or more strategic resources based on the outcome based performance metrics. However, Pisello does teach using KPI to measure performance (see ¶ 41).

Examiner takes Official Notice that it was well-known in the business management arts at the time the invention was made to track performance, for example using KPI.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Ann in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claim 8: Ann does not explicitly disclose assigning a weight to the at least one capability; and prioritizing the at least one capability based on the assigned weight.

Pisello teaches this limitation (see ¶ 34, disclosing assigning costs to resources for a project, which weigh into and prioritize the project that is eventually chosen; ¶¶ 36 and 40; ¶ 41,



disclosing key performance indicators which constitutes a measure of IT improvement).

Furthermore, it is old and well-known in the art to prioritize items.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the weighting techniques taught by Pisello when analyzing change impact as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate representation of the impact associated with enterprise changes.

Claim 10: Ann discloses implementing the at least one capability (see ¶ 47).

Ann does not explicitly disclose assigning outcome based performance metrics to the at least one capability.

Pisello discloses this limitation (see ¶¶ 41-47, disclosing KPIs related to proposed IT projects).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the metrics taught by Pisello when analyzing the impact of changes as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

The combination of Ann and Pisello does not explicitly disclose tracking the at least one capability based on the outcome based performance metrics. However, Pisello does teach using KPI to measure performance (see ¶ 41).

Examiner takes Official Notice that it was well-known in the business management arts at the time the invention was made to track performance, for example using KPI.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate well-known business management techniques into the method disclosed by Ann in order to track performance of implemented projects. One of ordinary skill in the art would have been motivated to do so for the benefit of accurately and efficiently determining the impact of implemented projects.

Claims 32-41: Claims 32-41 describe a system for carrying out the method steps recited in claims 1-10, rejected above. Ann and Pisello disclose such a system (e.g. a computer); thus, claims 32-41 are rejected under similar rationale as claims 1-10, rejected above.

Claim 52: Claim 52 describes a computer program product for carrying out the method steps recited in claim 1, rejected above. Ann and Pisello disclose such a computer program product (e.g. a computer); thus, claim 52 is rejected under similar rationale as claim 1, rejected above.

Claim 53: Ann discloses wherein the at least one customer requirement is defined in response to a request by a customer (see e.g. ¶ 9, 47).

Claim 54: Ann does not explicitly disclose wherein the value is monetary or in terms of strategic business worth.

Pisello teaches wherein the value is monetary (see ¶ 33, disclosing determining IT project costs; ¶¶ 39 and 43, disclosing cost savings; ¶ 40, disclosing a cost-benefit template; ¶¶ 51-56 disclosing cost-benefit indices for the projects; ¶ 91).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the analysis techniques taught by Pisello when analyzing the impact of proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

Claim 55: Ann does not explicitly disclose wherein the outcome based performance metrics are defined and tested by conducting facilitates working sessions or building simulation models.

Pisello predicting the expected values of KPIs due to project implementation (see ¶ 41).

Examiner takes Official Notice that it was well-known in the arts at the time the invention was made to perform simulations in order to forecast a value, for example a KPI.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform old and well-known simulations in order to determine the expected KPI values of Pisello when analyzing the impact of changes as disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more efficient and accurate way to measure the impact of changes.

Claim 56: Ann does not explicitly disclose wherein the estimates are at least one of entered, recorded, or modified as additional real performance information is observed.

Pisello discloses this limitation (see ¶¶ 33, 39, and 43).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the estimates taught by Pisello when analyzing the impact of proposed changes disclosed by Ann. One of ordinary skill in the art would have been motivated to do so for the benefit of a more accurate indication of the impact that a change will have on an enterprise.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- U.S. patent number 6,411,936 to Sanders, directed to enterprise value enhancement.
- U.S. pre-grant publication number 2003/0120533 to Popillo et al, directed to increasing business productivity and revenues by identifying critical interactions relating to customers.
- U.S. pre-grant publication number 2007/02755674 to Hemmat, directed to defining and sizing feasible approaches to business needs within an integrated development process
- U.S. pre-grant publication number 2004/0002883 to Andrews et al, directed to linking solution-specific process deliverables to a business-based delivery framework
- U.S. patent number 7,162,427 to Myrick et al, directed to modeling integrated business and IT frameworks and architectures in support of a business

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil R. Kardos whose telephone number is (571) 270-3443. The examiner can normally be reached on Monday through Friday from 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Neil R. Kardos  
Examiner  
Art Unit 3623

NRK  
7/2/08  
/Jonathan G. Sterrett/  
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